DOCKET NO.: MSFT-0117 / 147323.1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Marcus Peinado et al.

Serial No.: 09/525,509

Filing Date: March 15, 2000

Group Art Unit: Not Yet Assigned **Examiner: Not Yet Assigned**

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Assistant Commissioner for Patents Washington DC 20231

Dear Sir:

For:

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Pursuant to 37 C.F.R. §1.56 and in accordance with 37 C.F.R. §§1.97-1.98, information relating to the above-identified application is hereby disclosed. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 C.F.R. §1.56(b).

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There are no listed references which are not in the English language.

Date

April 17 2000

Steven H. Meyer

Registration No. 37,189

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| Form PTO-1449 Modified | i i | ocket No. ISFT-0117 | Serial No. 09/525,509 | | |
| List of Patent and Publications Cited by Applicant (Use several sheets if necessary) | , · | Applicant Marcus Peinado et al. | | | |
| U.S. Department of Commerce Patent and Trademark Office | | iling Date Iarch 15, 2000 | Group Not Yet Assigned | | |
| OTHER DOCUMENTS (Including Author | Title, Date, | Pertinent Pages, F | Etc.) | | |
| *AA "Aladdin Knowledge Systems Partners with Rights Exchange, Inc. to Develop a Comprehensive Solution for Electronic Software Distribution," August 3, 1998 | | | | | |
| AB Amdur, D., "Metering C | Online Copyrigh | ht," January 16, 19 | 96, 2 pages | | |
| AC Amdur, D. (ed.), "Interdon Electronic Commerce | _ | _ | | | |
| AD Armati, D., "Tools and a April 3, 1996 , 17 pages | standards for p | for protection, control and presentation of data," | | | |
| l X . l ' - | | arkets and virtual value chains on the information t Rev., Winter, 1995, 62-72 | | | |
| AF Cassidy, "A Web develo 1997, 5 pages | pers guide to c | ontent encapsulatio | n technology," April, | | |
| AG Clark, T., "Software Sec September 25, 1995, 1 p | _ | ontent on Web," In | teractive Week, | | |
| AH Cox, B., "Superdistribut | ion," <i>Idees For</i> | Fortes, September, 1994, 2 pages | | | |
| AI Cox, B., "What if There 1992, 8-9 and 76 | Is A Silver Bu | er Bullet," J. Object Oriented Programm., June, | | | |
| AJ Griswold, G.N., "A Met Property Project Proceed | | | | | |
| AK Hauser, R.C., "Does lice 1993, 9 pages | ensing require | new access control | techniques?" August, | | |
| AL Hudgins-Bonafield, C. "Selling Knowledge on the Net," Network Computing, 1, 1995, 102-109 | | | | | |
| AM "IBM spearheading intell the Internet," May, 1996 | | y protection technol | logy for information on | | |
| EXAMINER Vavidle | D | ATE CONSIDER | ED 2/10/03 | | |

| | Form | PTO-1449 Modified | Docket No. MSFT-0117 | Serial No. 09/525,509 | | | |
|--|--|--|---|----------------------------|--|--|--|
| Onn . | 티 (| Patent and Publications Cited by Applicant veral sheets if necessary) | Applicant Marcus Peinado et | al. | | | |
| CATENT & TRADEME | | epartment of Commerce and Trademark Office | Filing Date March 15, 2000 | Group Not Yet Assigned | | | |
| OTHER D | OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | |
| AN "Technological Solutions Rise to Complement Law's Small Stick Guarding Electronic Works," Information Law Alert, June 16, 1995, 3-4 and 7 | | | | | | | |
| | AO | Kaplan, M.A., "IBM Cryptolopes_, Management," December, 1996, 7 p | _ | nd Digital Rights | | | |
| | AP | Kent, S.T., "Protecting externally su September, 1980, 1-42 and 250-252 | | nall computers," | | | |
| | AQ | | cital Library Contents and Users; Protecting " D-Lib Magazine, September, 1997, 9 pages | | | | |
| | AR | Linn, R.J., "Copyright and Information Research and Education Network," January, 1994 , 1(1), 1 and 10-20 | | | | | |
| | AS | McNab, L., "Super-distribution wor 1998, 2 pages | orks better in practical applications," March 2, | | | | |
| | AT | Moeller, M., "NetTrust lets Cybers, November 20, 1995, 12(48), 1 page | space Merchants Take Account," PC Week, | | | | |
| | AU | Moeller, M., "IBM takes charge of SET," April, 1996, 4 pages | E-commerce; Plans cl | ient, server apps based on | | | |
| | AV | Pemberton, J., "An ONLINE Interv 1996, 7 pages | iew with Jeff Crigler | at IBM InfoMarket," July, | | | |
| | ent system links content, ishing, 1996, 10(11), | | | | | | |
| | AX | Sibert, O. et al., "The DigiBox: A Sel First USENIX Workshop on Electron | • | | | | |
| | AY | Sibert, O. et al., "Securing the Conf July, 1995 , 1-11 | ent, Not the Wire, for | r Information Commerce," | | | |
| EXAMINE | CR | | DATE CONSIDER | ED | | | |

| | —————————————————————————————————————— | | | | |
|--|---|--|--|--|--|
| Form PTO-1449 Mod | MSFT-0117 | Serial No. 09/525,509 | | | |
| List of Patent and Publica Cited by Applicant Use several sheets if nece | Marcus Peina | Applicant Marcus Peinado et al. | | | |
| U.S. Department of Comp Patent and Trademark Of | I | Group Not Yet Assigned | | | |
| OTHER DOCUMENTS (Including | Author, Title, Date, Pertinent Pa | ges, Etc.) | | | |
| 1 1 1 1 | , "A New Set of Rules For Information of the set of Rules For Information of | nation Commerce," Electronic | | | |
| BA Stefik, M., 'Trust | ed Systems," March, 1997, 8 page | S | | | |
| 1 1 1 1 | ng the Possible: How Trusted Sys Us to Rethink Digital Publishing," | | | | |
| BC Tarter, J. (ed.), "7 13(6), 1-6 | The Superdistribution Model," Soft | oution Model," Soft Trends, November 15, 1996, | | | |
| BD "Rights Managem 1997, 4, 3 pages | ent in the Digital Age: Trading in | al Age: Trading in Bits, Not Atoms," Spring, | | | |
| BE Weber, R., "Digit | al Rights Management Technology | ement Technology," October, 1995, 1-49 | | | |
| , , , , , , , , , , , , , , , , , , , | 'ABYSS: An Architecture for Soneering, June, 1990, 16(6), 619-62 | • | | | |
| l l l l | "ABYSS: A trusted architecture furity and Privacy, April 27-29, 19 | - | | | |
| BH "Boxing Up Bytes | " 2 pages | | | | |
| i i i | A. et al., "Digital Content & Intell age and tools for rights management | - · · | | | |
| | | | | | |
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| EXAMINER | DATE CONSI | DERED | | | |

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List of Patent and Publications
Cited by Applicant
Use several sheets if necessary)

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U.S. Department of Commerce Patent and Trademark Office

Filing Date

March 15, 200

Group

March 15, 2000 Not Yet Assigned

U. S. PATENT DOCUMENTS

| Examiner Initial | | Document No. | Date | Name | Class | Subclass |
|---------------------|----|-----------------|----------|-------------------|-------|----------|
| BL | BJ | 3,718,906 | 02/27/73 | Lightner | 340 | 147 R |
| | BK | 4,323,921 | 04/06/82 | Guillou | 358 | 114 |
| | BL | 4,528,643 | 07/09/85 | Freeny, Jr. | 364 | 900 |
| | BM | 4,658,093 | 04/14/87 | Hellman | 380 | 25 |
| | BN | 4,683,553 | 07/28/87 | Mollier | 380 | 4 |
| | ВО | 4,827,508 | 05/02/89 | Shear | 380 | 4 |
| | BP | 4,916,738 | 04/10/90 | Chandra et al. | 380 | 25 |
| | BQ | 4,953,209 | 08/28/90 | Ryder, Sr. et al. | 380 | 23 |
| | BR | 4,977,594 | 12/11/90 | Shear | 380 | 4 |
| | BS | 5,050,213 | 09/17/91 | Shear | 380 | 25 |

FOREIGN PATENT DOCUMENTS

| Examiner Initial | | Document No. | Date | Country | Translation YES NO |
|---------------------|----|-----------------|----------|---------|-----------------------|
| BAL | ВТ | EP 0 715 246 A1 | 06/05/96 | ЕРО | X |
| | BU | EP 0 715 247 A1 | 06/05/96 | ЕРО | X |
| | BV | WO 93/01550 | 01/21/93 | PCT | X |
| | BW | WO 96/13013 | 05/02/96 | PCT | X |
| | | | | | |

EXAMINER

DATE CONSIDERED

Form PTO-1449 Modified

List of Patent and Publications
Cited by Applicant
See several sheets if necessary)

7.S. Department of Commerce Patent and Trademark Office

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Group

Not Yet Assigned

U. S. PATENT DOCUMENTS

| Examiner Initial | | Document No. | Date | Name | Class | Subclass |
|---------------------|----|-----------------|----------|------------------|-------|----------|
| Dal | BX | 5,103,392 | 04/07/92 | Mori | 395 | 725 |
| \ | BY | 5,103,476 | 04/07/92 | Waite et al. | 380 | 4 |
| | BZ | 5,109,413 | 04/28/92 | Comerford et al. | 380 | 4 |
| | CA | 5,117,457 | 05/26/92 | Comerford et al. | 380 | 3 |
| | СВ | 5,193,573 | 03/16/93 | Chronister | 137 | 315 |
| | CC | 5,222,134 | 06/22/93 | Waite et al. | 380 | 4 |
| | CD | 5,319,705 | 06/07/94 | Halter et al. | 380 | 4 |
| | CE | 5,410,598 | 04/25/95 | Shear | 380 | 4 |
| | CF | 5,509,070 | 04/16/96 | Schull | 380 | 4 |
| V | CG | 5,629,980 | 05/13/97 | Stefik et al. | 380 | 4 |

FOREIGN PATENT DOCUMENTS

| Examiner Initial | | Document No. | Date | Country | Translation YES NO |
|---------------------|----|--------------|----------|------------|-----------------------|
| Da | СН | WO 96/24092 | 08/08/96 | PCT | X |
| 1 | CI | WO 96/27155 | 09/06/96 | PCT | Х . |
| | CJ | WO 97/25798 | 07/17/97 | PCT | Х |
| | CK | WO 97/43761 | 11/20/97 | PCT | Х |
| | CL | WO 98/09209 | 03/05/98 | PCT | X |
| EXAMINER | | | | DATE CONSI | DERED |

Form PTO-1449 Modified

MSFT-0117

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List of Patent and Publications Cited by Applicant (Use several sheets if necessary) **Applicant**

Docket No.

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U.S. Department of Commerce Patent and Trademark Office

Filing Date March 15, 2000 Group

Not Yet Assigned

U. S. PATENT DOCUMENTS

| Examiner Initial | | Document No. | Date | Name | Class | Subclass |
|---------------------|----|-----------------|----------|-----------------|-------|----------|
| DRL | CM | 5,634,012 | 05/27/97 | Stefik et al. | 395 | 239 |
| | CN | 5,638,443 | 06/10/97 | Stefik et al. | 380 | 4 |
| | CO | 5,673,316 | 09/30/97 | Auerbach et al. | 380 | 4 |
| | СР | 5,710,887 | 01/20/98 | Chelliah et al. | 395 | 226 |
| | CQ | 5,715,403 | 02/03/98 | Stefik | 395 | 244 |
| | CR | 5,765,152 | 06/09/98 | Erickson | 707 | 9 |
| | CS | 5,809,144 | 09/15/98 | Sirbu et al. | 380 | 25 |
| | CT | 5,845,281 | 12/01/98 | Benson et al. | 707 | 9 |
| | | | | | | |
| | | | | _ | | |

FOREIGN PATENT DOCUMENTS

| Examiner Initial | | Document No. | Date | Country | Translatio YES | n NO |
|---------------------|---------|--------------|----------|------------|-------------------|---------|
| Dar | CU | WO 98/10381 | 03/12/98 | PCT | X | _ |
| | CV | WO 98/21679 | 05/22/98 | PCT | X | |
| | CW | WO 98/24037 | 06/04/98 | PCT | X | |
| $\overline{}$ | CX | WO 98/37481 | 08/27/98 | PCT | X | |
| EVAMINE | <u></u> | _ | | DATE CONSI | DEDED | |

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DATE CONSIDERED